

### REMARKS

Claims 1, 2, 3, 4 and 9-14 have been cancelled, claims 3 and 5 have been rewritten in independent form without amendment, the claims dependent thereon are presented without amendment, and claims 15-28 have been amended to further patentably distinguish the invention from the prior art. Such amendments to claims are only for the purpose of expediting the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

Claims 3, 5-7, 15-18, 20, 21, 23, 24 and 26 as originally presented stood rejected under 35 U.S.C. § 102(b) as being unpatentable over Thomason. The reference is said to disclose a rolled product of contiguous separable sheets comprising at least a first and second contiguous separable sheet of product 11 wound around an axis forming a cylindrical roll, each sheet having an outer edge division parallel to the axis, at least the first and second contiguous separable sheets of product having at least one indicium said to be 14 that bears a predetermined relationship when the first sheet is the outermost sheet of the rolled product, such that discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll, at least first and second contiguous separable sheets of product are said to be wound around the cylindrical core, the indicium is said to be a continuous undulating indicium, with specific reference to 14' in FIG. 4, at least the first and second sheet of contiguous separable sheets of product 11 said to have a plurality of indicium 14, the plurality of indicium are said to each be a continuous undulating indicium, the plurality of indicium being out-of-phase from each other, the continuous undulating indicium being sinusoid-shaped having a predetermined wavelength, the sheets are said to be toilet paper, with specific reference to column 1, paragraph 1, the sheets are said to be paper toweling, with specific reference to column 1, paragraph 1, the indicium is said to be printed on the sheets, with specific reference to column 2, paragraph 7, during normal manufacturing of the rolled product, the method is said to comprise of claims 15-18 are said to be used, a roll of contiguous separable sheets of product 11 said to comprise a visually

perceivable mark 14 extending continuously along the length of each of the sheets and forming a pattern such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby said to allow the end of the rolled product to be visually located, a plurality of undulating visually perceivable marks are said to extend continuously along the length of the sheets, the mark is said to be printed on the sheets, with specific reference to column 2, paragraph 7.

This ground of rejection is respectfully traversed as to the remaining active original claims and claims currently amended.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval

from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. \*\*\* The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. \*\*\* The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

Original claim 3, original claims 5-8 and the currently amended claims all require the indicium as being continuous, such as 52 and 51, and as described on page 3 of the specification beginning at line 6. The reference fails to disclose this limitation, disclosing the discontinuity between the indicium spanning the four sheets shown in FIG. 4 and those on the fragmentarily illustrated sheets at each end. Accordingly, withdrawal of the rejection of the active claims as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to the continuous undulating indicium or the visually perceivable mark extending continuously along the length of each of the sheets continuously for the length of the entire roll.

3, 4. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason as a primary reference in view of Clayton as a secondary reference. The primary reference is said to disclose a rolled product of contiguous separable sheets as described in the office action in paragraph 2, but does not disclose the sheets as being plastic bags. The secondary reference is said to disclose a rolled product being separable sheets of plastic bags. Therefore, it is said it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to use the indicia disclosed by Thomason with a rolled product comprised of separable sheets of plastic bags as said to be taught by the secondary reference in order to determine the free end of the rolled product, and since the primary reference suggests that the indicia could be used with products manufactured in a rolled form, with specific reference to column 1, lines 1-10.

This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

Nothing in the references suggests the desirability of combining what is there disclosed to meet the terms of claim 25 as amended. The reasoning set forth above in support of the patentability of parent claim 20 is submitted to support the patentability of claim 25 so that

further discussion of the secondary reference is submitted to be unnecessary. Furthermore, it is impossible to combine the primary and secondary references to meet the terms of claim 25.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992).

The inability to combine the primary and secondary references to meet the terms of claim 25 is reason enough for withdrawing the rejection of claim 25 as unpatentable over the primary and secondary references.

If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to an element in claim 25, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of this claim.

7. Claims 8, 19 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thomason. The reference is said to disclose the rolled product as described in the office action in paragraph 2 including the sheets being of length L. The reference does not disclose the particular value of the wavelength of each of the sinusoid-shaped indicium being substantially equal to L. With respect to the particular value of the wavelength of each of the sinusoid-shaped indicia being substantially equal to L, to make the wavelength of each of the sinusoid-shaped indicia being substantially equal to L, is only considered to be the optimum value of the wavelength of each sinusoid-shaped indicium said to be disclosed by the reference that a person having ordinary skill in the art at the time the invention was made would have been able to determined using routine experimentation based, among other things, on the desired accuracy, and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, with specific reference to *In re Boche*, 205 U.S.P.Q. 215 (C.C.P.A. 1980). Therefore, it is said it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the wavelength of each of the

sinusoid-shaped indicia being substantially equal to L in order to save on manufacturing costs by imprinting a lesser amount of sinusoidal-shaped indicia on the rolled product.

This ground of rejection is respectfully traversed. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The reliance on *In re Boesch*, 205 U.S.P.Q. 215 (C.C.P.A. 1980) is inapposite. There the court observed the board agreed with the examiner that the claimed alloys were *prima facie* obvious where there was no substantial disagreement that both references disclose alloys having compositional limits overlapping those of the claimed alloy. Here the reference has no comparable disclosure of the claimed invention and fails to suggest the desirability of modifying what is disclosed to meet the terms of the rejected claims.

We have shown above that the reference fails to disclose the indicium extending continuously along the length of the roll, and nothing in the reference suggests the desirability of modifying what is there disclosed to make each of the sinusoid-shaped marks have a wavelength substantially equal to L. Accordingly, withdrawal of the rejection of claims 8, 19 and 22 as unpatentable over the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in claims 8, 19 and 22 and quote verbatim the language regarded as suggesting the desirability of modifying what is disclosed in the reference to meet the terms of claims 8, 19 and 22.

8. The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, have been examined and are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing cancellations, amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, she is respectfully

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Serial No. : 10/068,078  
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Page : 11 of 11

Attorney's Docket No.: 13808-002001

requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps she believes are necessary to place the application in a condition for allowance.